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EXAMINER

OPIE, GEORGE L

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/517,366  
Filing Date: March 02, 2000  
Appellant(s): BARBER ET AL.

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Philip S. Lyren  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 6<sup>th</sup>, 2006 appealing  
from the Office action mailed November 1<sup>st</sup>, 2005

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

Claims 21-30 and 38-40 stand rejected under 35 U.S.C. 101. Claims 1-20 and 31-37 have been ALLOWED. The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 U.S.C. § 101

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 101 that form the basis for the rejections under this section made in this Office action:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title

Claims 21-30 and 38-40 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Pages 5-6 of Appellant's specification provide guidance as to what falls within the scope of the phrase "computer-readable medium" as recited in

rejected claims 21-30 and 38-40. The pertinent portion of pages 5-6 are as follows:

In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer readable medium can be, for example but not limited to, an electronic, magnetic, optical, **electromagnetic, infrared**, or semiconductor system, apparatus, device, or **propagation medium**. More specific examples (a nonexhaustive list) of the computer-readable medium would include the following: an electrical connection (electronic) having one or more wires, a portable computer diskette (magnetic), a random access memory (RAM) (electronic), a read-only memory (ROM) (electronic), an erasable programmable read-only memory (EPROM or Flash memory) (electronic), an optical fiber (optical), and a portable compact disc read-only memory (CDROM) (optical). Note that the computer-readable medium could even be paper or another **suitable medium upon which the program is printed**, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory.*[emphasis added]*

Appellant has provided intrinsic evidence in the specification that the phrase "computer-readable medium" as used in the claims is intended to cover media which would have been recognized by one of ordinary skill at the time of the invention as storage media, **propagation or transmission media, and printed matter**.

Appellant's inclusion of a piece of **paper with the program printed thereon** within the scope of "computer-readable medium" indicates the claims are sufficiently broad to read on non-functional descriptive material, per se, printed matter. Printed matter which fails to be functionally interrelated to its substrate has long been held to be nonstatutory.

From M.P.E.P. 706.03(a):

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

Likewise, Applicant's inclusion of propagation or transmission media which would have been reasonably interpreted by one of ordinary skill as a form of energy rather than process, machine, manufacture or composition of matter is evidence that the claim is not limited to statutory subject matter, instead covering both non-statutory subject matter and statutory subject matter. As such, rejection of the claim under 35 USC 101 is believed appropriate.

As such, claims 21-30 and 38-40 are not limited to embodiments which would enable the program to act as a computer component and realize its functionality to provide a practical application with a useful, concrete and tangible result.

#### **(10) Response to Argument**

At the outset, the only remaining rejections are under 35 U.S.C. 101, all remaining claims have been allowed.

The following is intended to clarify the history for a portion of the rationale present in this Examiner's Answer for holding the claims non-statutory. In the non-Final rejection of 08-02-2005, the rationale for the rejection included:

It is not believed, however, that the recited propagation or transmission media would likewise enable the functionality to be realized. Absent recitation of some means for receiving and processing the program, propagation or transmission media are not believed to be, in and of themselves, capable of providing the program in a manner which enables it to be read and executed by a computer, with subsequent realization of its functionality to accomplish a practical application by causing the computer to perform operations with a useful, concrete and tangible result.

The Office position with respect to the propagation or transmission media encompassed by Appellant's claims changed between the time of the non-Final rejection and that of the Final rejection of 11-01-2005. Thus the Final rejection included:

It is likewise believed that the recited propagation or transmission media would enable the functionality to be realized.

The USPTO has since published a notice setting forth interim guidelines for the examination of patent applications for patent subject matter eligibility under 35 U.S.C. 101. See *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, 1300 Off. Gaz. Pat. Office 142 (Nov. 22, 2005) (Interim Guidelines).

The appealed claims recite a computer-readable medium. Appellant's specification, as noted above, sets forth intrinsic evidence that the computer-readable medium is intended to include items which one of ordinary skill in the art would have recognized as propagation or transmission media which is a form of energy. Therefore, consistent with the Interim Guidelines, the claimed subject

matter is not currently believed to be limited to that which falls within a statutory category of invention, because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy.

Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a device or combination of devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter. As such, Appellant's inclusion of such media within the bounds of computer-readable medium is again being used as evidence the claims should be rejected as non-statutory in addition to the intrinsic evidence of record that Appellant intends for the computer-readable medium to include a piece of paper with the instructions printed thereon. The Examiner apologizes for any inconvenience caused by reinstating this portion of the rationale.

It should be noted that there is a Request for Comments that was published in the Official Gazette December 20, 2005, which enables Appellant to submit comments through June 30, 2006, to the questions posed by those that set the Office policies, including the policies which form the basis for the reinstated rationale. In the mean time, the rejections contained herein are believed consistent with all applicable laws, rules and Office policies and are set forth in this Examiner's Answer responding to the Appeal Brief.

Appellant's argument that the examiner's rejection based on the claims covering a form of printed matter conflicts with current case law is believed to be flawed and rendered moot by the exact passages quoted by Appellant. Appellant's citations are believed to support the Examiner's rejection. In the embodiment covered by Appellant's claims where the computer readable medium is a piece of paper, the result is a piece of paper upon which the instructions have been printed, i.e., printed matter.

Absent the unclaimed program and hardware for electronically capturing and compiling this printed matter into machine readable form, it is a claim "defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind." Likewise, nothing about Appellant's claims "*requires* that the information be processed not by the human mind but by a machine, the computer."

The invention as defined by the claims covers a piece of paper with the instructions printed thereon, not a process of executing the instructions with a machine. Appellant's argument that *Beauregard* somehow establishes that a piece of paper with instructions written on it is patent-eligible subject matter is believed to likewise be displaced. As printed matter, the program instructions are non-functional descriptive material. It's not until they are converted into an appropriate electronic form to be read and processed by the computer and cause the computer to perform the requisite functionality that they become functional descriptive material.

Appellant has provided intrinsic evidence in their specification and is arguing that the claims in question are intended to cover a piece of paper with the instructions printed thereon and are not intended to only cover "computer programs embodied in a tangible medium, such as floppy diskettes...." As such, it is believed that Appellant's argument that the rejection is not consistent with *Beauregard* is incorrect, and therefore it is not believed it should be persuasive.

Appellant next argues that "claims 21-30 and 38-40 require that information is processed, not by the mind, but by a machine." Since claims 21-30 and 38-40 are directed to the medium itself and not execution of the instructions, these claims do not require information to be processed at all, much less be processed by a machine.

The recitation of "computer elements" that Appellant alleges appear in claim 21 are, in fact, not recited elements of claim 21, but elements associated with the functionality which would occur if the instructions of claim 21 were executed, something not actually required by claim 21, since it is directed to the medium and instructions, not execution of the instructions.

Since the legal precedent cited by Appellant is believed to actually support the rejection made by the examiner, it is respectfully requested that the Board sustain the rejections herein.

Appellant next states *In re Jones*, "supports the position of the Applicants [sic - Appellants]." Nothing in *In re Jones* could be found to support the notion that instructions written on piece of paper are patent-eligible subject matter.

Appellant again erroneously characterizes claim 21 as reciting "numerous elements for performing operations on a computer...." As indicated above, these elements are associated with the functionality which would occur if the claimed instructions were executed and are not recited as elements of claim 21.

Appellant's argument that the "printed program performs operations on a computer" is not understood, since a printed program is believed incapable of performing any operations on a computer.

In the event the "computer-readable medium" of the appealed claims was limited to embodiments which established a statutory category of invention and was structurally and functionally interrelated to the instructions so as to impart functionality to a computer when employed as a computer component, the examiner would be in agreement that the instructions would produce a useful, concrete and tangible result when executed, and the claims would be directed to patent-eligible subject matter. However, for the reasons above, that is not believed to be the case.

Instead, Appellant's specification is believed to provide intrinsic evidence the medium is intended to cover a form of energy and to cover a piece of paper with instructions written thereon. Neither of these forms of media are believed to be appropriate computer readable media to claim in combination with the recited instructions and establish patent-eligible subject matter. Thus, Appellant's arguments that the claim produces a useful, concrete and tangible result are not germane to the issue at hand.

As noted in the Interim Guidelines, they are intended to supercede all prior guidance provided by the Office. Thus, Appellant's final argument that the examiner has failed to follow prior guidance is moot.

For the reasons above, it is believed the rejections should be sustained.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2194

Respectfully submitted,

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